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# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 33764

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on December 30, 2005

Signature: Suzanne B. Gagnon

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| Application Number | Filed |
|---|---|
| 09/869,647 | 07/02/2002 |

First Named Inventor: Hiruyasu Karimoto

| Art Unit | Examiner |
|---|---|
| 2176 | William L. Bashore |

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ attorney or agent of record. Registration number 48924.
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

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Date: December 30, 2005

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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PRE-APPEAL BRIEF CONFERENCE REMARKS

These remarks/arguments are filed along with a Notice of Appeal and a Pre-Appeal Brief Request for Review in response to the Office Action dated August 3, 2005.

Claims 1-3, 8-10, 15-21 and 23-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mindrum (U.S. 6,340,780) in view of Arellano et al. (U.S. 6,694,482).

Claim 1 recites "extracting, from said database, elements indexes for multiple creation elements that match a selection reference" and "linking creation elements corresponding to element indexes that belong in said set, and outputting the results as a new creation." Independent claim 8 also recites similar limitations. The Examiner states on page 3 of the Office action, 08-03-2005, "Mindrum teaches a user accessing the database for specific information (i.e. element indexes) via an interactive headstone. The results are outputted to the user as a creation."

Mindrum teaches the creation of a "Life Story" of an individual by collecting documents about the individual and storing the data in a database (col. 8, line 66, to col. 10, line 36). The data may be tagged with the date of a photo, names or written description (col. 10, lines 29-36). A database table for storing the information is indicated in col. 10, lines 37-67. The Life Story is developed based on a chosen format, and a media presentation piece of the Life Story is created (col. 11, lines 33-67). The end user can access the deceased's Life Story data through an interactive headstone (col. 14, lines 5-35) by selecting a period of time or specific item of the Life Story to view (col. 16, lines 8-67).

In Mindrum, the database is accessed when the end user selects specific information of the Life Story to view. However, this specific information is merely a previously recorded document of the Life Story and not a corresponding index of a Life Story recorded document. Thus, Mindrum

only teaches that a Life Story recorded document matching a user selection is extracted from the database.

A review of Mindrum does not indicate any suggestion that a document index that matches a user selection is extracted from the database. Accordingly, Mindrum does not teach extracting elements indexes matching a selection reference from the database as in claim language of claims 1 and 8.

Since document indexes have not been extracted from the database, Mindrum also does not teach linking recorded documents corresponding to a set of document indexes as in claims 1 and 8. Furthermore, the Examiner fails to address how the outputted recorded documents result in a *new* creation. Although Mindrum does output selected recorded documents to the user, these resulting recorded documents are not a new creation but a part of the existing Life Story. Therefore, the combination of Mindrum and Arellano does not disclose or suggest all the claim limitations of claims 1 and 8.

Claim 1 also recites, "calculating a correlation among information sets written in said extracted element indexes, and obtaining a set of element indexes from said extracted element indexes whose correlation satisfies an evaluation reference". Independent claim 8 also recites similar limitations. The Examiner states, "Mindrum does not specifically teach calculating a correlation among sets and obtaining sets satisfying an evaluation reference. However, Arellano teaches a method of creating an interactive multimedia application that can dynamically adapt to a user" (Office action 08-03-2005, page 3).

As discussed in the response of October 21, 2005 (pages 2-3), Arellano may disclose a User Agent for analyzing and computing correlations with regard to a user's preferences and interests. However, the User Agent in Arellano does not analyze or compute correlations between any *indexes* of the content elements of the presentation. The user's preferences and the content elements of the

presentation of Arellano are clearly different items. In fact, Arellano does not deal with any indexes of the content elements at all. Therefore, Arellano does not teach calculating a correlation among index information of the content elements. Arellano also does not teach obtaining a set of indexes of the content elements whose correlation satisfies an evaluation reference. Accordingly, the combination of Arellano and Mindrum do not suggest calculating a correlation among information written in element indexes or obtaining a set of element indexes whose correlation satisfies an evaluation reference as in claims 1 and 8.

Claim 3 recites, "said element indexes include 5W1H information that represents the contents of a pair of said elements". Dependent claims 10 and 21 also recite similar limitations. The Examiner states on page 3 of the Office action, 08-03-2005, "Mindrum does not specifically teach "5W1H" information." However, the Examiner then goes on to state, "The information provided typically includes life information ..., providing reasonable suggestion to the skilled artisan to use 5W1H type information to describe a person's life stored in the form of a plurality of element indexes (i.e. a pair, etc.)."

As noted previously, Mindrum discloses a database table in col. 10, lines 37-67, but there is no suggestion in the database table of including 5W1H in the indexes of the recorded documents. Therefore, Mindrum does not suggest in anyway of including 5W1H in the indexes of the recorded documents as in claims 3, 10, and 21.

Claims 19 recites, "agitation means for performing, according to a pseudo physical rule, agitation simulation for said plurality of scenario element indexes, and for repeating said agitation simulation until a set of scenario element indexes is obtained from said plurality of scenario element indexes that match an evaluation reference for a predetermined condition setting for a scenario creation". Independent claim 8 also recites similar limitations. The Examiner fails to indicate where Mindrum or Arellano disclose such limitations, but the Examiner does state in part, "Mindrum's

invention allows for updating a person's Life Story as new information is submitted, therefore, each update can result in a new simulation" (Office action 08-03-2005, page 7).

As mentioned previously, Mindrum teaches the creation of a "Life Story" of an individual by collecting documents about the individual and storing the data in a database. In Mindrum, while a person is alive, the person's Life Story can be updated with new information, which produces a new Life Story rendition. Once a person is deceased, the end user can access the deceased's Life Story data through an interactive headstone.

With further regards to the response of October 21, 2005 (pages 5-6), the updating of the Mindrum a Life Story clearly does not teach performing agitation simulation on element indexes of Life Story recorded documents. Mindrum and Arellano do not teach performing agitation simulation for scenario element indexes and the Examiner has failed to point out where in such teaching is found in the references. Mindrum and Arellano also do not teach repeating such agitation simulation until a set of scenario element indexes is obtained that match an evaluation reference.

Finally, the Examiner has also failed to support a *prima facie* case of obviousness. The Examiner merely states a generalized benefit of updating a Life Story presentation. This is not a motivation to combine one reference with another reference. Such an interpretation of motivation would make every reference self-motivating, because all references teach some benefit. Therefore, this is not legally sufficient.

For examiner, the Examiner states that it would be obvious to apply Arellano to Mindrum "providing Mindrum the benefit of dynamically updating a Life Story presentation by automatically choosing the best appropriate material submitted by friends of the deceased" (Office action 08-03-2005, page 3). This statement is nothing more than a generalized summary of the benefits taught by Mindrum.

Further, Arellano deals with representing interests and trends of a user, and then adapting a story based on the user's interests. Since the Life Story in Mindrum is the Life Story of the deceased, there would be no motivation to have user's interests added to the deceased's Life Story. Accordingly, one skilled in the art would not be motivated to use Arellano user's trends to modify the Mindrum deceased's Life Story. Since there is no motivation to combine the references in order to teach each of the limitations, a *prima facie* case of obviousness has not been made by the Office Action.

Claims 6, 7, 13, 14, 22 are rejected under 35 U.S.C. are rejected under 35 U.S.C. 103(a) as being unpatentable over Mindrum in view of Arellano, and further in view of Kay (U.S. Patent 6,103,964).

Dependent claims 7 and 14 recite similar limitations as those in claim 3 and as such the same remarks/remarks are applied to claims 7 and 14.

If there are any fees required by the foregoing Response, please charge the same to our Deposit Account No. 16-0820, our Order No. 33764.

Respectfully submitted,

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